

THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of

Guy D. DIANA et al.

Application No. 10/511,430

Filing Date: August 18, 2005

For: COMPOUNDS, COMPOSITIONS
AND METHODS FOR TREATING OR
PREVENTING VIRAL INFECTION
AND ASSOCIATED DISEASES

: Examiner: B. M. Robinson

: Group Art Unit: 1625

: Confirmation No: 2400

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Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

**RESPONSE TO REQUIREMENTS FOR
RESTRICTION AND ELECTION OF SPECIES**

Dear Sir:

In response to the requirement for restriction under 35 USC §§121 and 372, as set forth in the Official Action dated February 1, 2008, in the above-referenced patent application, applicants hereby provisionally elect, without traverse, the Group I invention, namely, the compounds of claims 1-9.

Regarding the additional requirement for election of species set out in the February 1, 2008 Official Action, applicants respectfully take exception to the examiner's assertion, at page 3 of the Official Action, that the species lack a common core. On the contrary, all of the disclosed species have in common a pyridoxal 5-phosphate nucleus. Nevertheless, in the interest of advancing the prosecution of this application, applicants further provisionally elect, without traverse, the species, phosphoric acid mono-(5-hydroxy-6-methyl-4-[2-methyl-1-tetrazolylimino]methyl-pyridin-3-yl)methyl ester, i.e. the compound of formula I in which X is -CH=N-, R1 is methyl and R is 2-methyltetrazol-1-yl, which is described in further detail in Example 1. Claims 1-6 are believed to be readable on the elected species.

Applicants' elections in response to the present requirements for restriction and election of species are made without prejudice to applicants' right to file a divisional application, as provided under 35 USC §121, on the subject matter of any claims finally held withdrawn from consideration in this application.

The Examiner has required restriction between product and method. In accordance with the decisions in *In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fed. Cir. 1995) and *In re Brouwer*, 77 F3d 1565, 37 USPQ2d 1663 (Fed. Cir.), and the notice published in the Official Gazette on March 26, 1996, setting forth new guidelines for the treatment of restricted product and method claims (see 1184 O.G. 86), Applicants respectfully requests that if the restriction requirement is made final and if the claims of elected Group I (claims 1-9) are found allowable, then the remaining claims be rejoined and examined for patentability. See also M.P.E.P. § 821.04.

Lastly, it is noted that a shortened statutory response period of one (1) month was set in the February 1, 2008 Official Action. The initial response period, therefore, expires March 3, 2008, as March 1 fell on a Saturday. The present Response to Requirements for Restriction and Election of Species, is being filed before the expiration of initial response period.

Early and favorable action on the merits of this application is respectfully requested.

Respectfully submitted,

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